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**TRANSMITTAL LETTER
(General - Patent Pending)**

Docket No.
NERE-2842

Re Application Of: **Nerenberg et al.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/584,610	5/31/00	Rimell, S.	5409	2175	

Title: **DEATH VISUALIZATION THERAPY**

COMMISSIONER FOR PATENTS:

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Reply Brief (30 pages)

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DOCKET NO. NERE-2842

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Nerenberg *et al.*

Examiner: Rimell, S.

Serial No.: 09/584,610

Art Unit: 2175

Filed: 5/31/00

For: **DEATH VISUALIZATION THERAPY**

Commissioner for Patents
P.O. Box 1450
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REPLY BRIEF OF APPELLANT

This Reply Brief is in reply to the Examiner's Answer mailed October 31, 2005.,

Ground of Rejection 1

Claims 1, 4-8, 12-17 and 19-21 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by the alleged reference “Death Visualization Therapy” by Arnold P. Nerenberg, PhD. Hereinafter, the reference of “Death Visualization Therapy” by Arnold P. Nerenberg, PhD is identified as the “DVT Reference”.

Claims 1 and 19

As to claims 1 and 19, the Examiner’s Answer alleges: “Page 8 describes the provision of a coffin in a closed room for the purpose of conducting a psychological therapeutic method. As described on page 19, a first person (Joe's Mother) and a second person (Joe) and brought into the room. The second person (Joe) is directed to lay in the coffin. The first person (Joe's mother) can see the second person (Joe) in the coffin and is directed to speak to the second person (Joe) in regards to their personal relationship. Neither the first person or second personal are rehearsing or acting in a theatrical performance.” As to claim 19, the Examiner’s Answer alleges: “See remarks for claim 1. Prior to the implementation of the method, both the first person (Joe's Mother) and the second person (Joe) are questioned (page 6, entire page)”.

Appellants respectfully contend that the DVT Reference does not anticipate claims 1 and 19, because the DVT Reference does not teach each and every feature of claims 1 and 19.

As a first example of why the DVT Reference does not anticipate claims 1 and 19,

Appellants respectfully contend that the DVT Reference does not teach “wherein the coffin is visually available to the first person”.

The Examiner’s Answer has identified Joe’s mother as the first person (i.e., the person outside of the coffin) and Joe as the second person (i.e., the person in the coffin). However, the Examiner’s Answer has not cited anything in the DVT Reference that explicitly teaches that the coffin is visually available to the first person. Instead, the Examiner’s Answer in “Response To Argument” argues that the DVT Reference **inherently** teaches that the coffin is visually available to the first person.

In particular, the Examiner’s Answer in “Response To Argument” states: “Page 19 of DVT describes the scenario where the second person (Joe) is in the coffin and the first person (Joe's mother) speaks to him. In order to speak to him, she would have to communicate to him while he was in the coffin, requiring that she see the coffin. There is no suggestion that the Joe's mother speak to him from a distant location, through an opaque partition, through a wall in an adjacent room or via telephone, as appellant suggests. There is no statement in the booklet that such indirect conversation occurs. The conversation on page 19 can only occur as described by direct communication with Joe while he is laying in the coffin.”

In response, Appellants disagree with the Examiner’s preceding argument that the DVT Reference **inherently** teaches that the coffin is visually available to the first person. Under case law, the alleged inherency must **necessarily and inevitably** follow from the teachings in the prior art and a high probability of occurrence is not sufficient for demonstrating inherency. See *The Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1320 (Fed. Cir. 2004) (holding that “the district court did not address a critical question for inherent anticipation: whether ... practicing the ‘516

patent necessarily featured or resulted in limitation (c) of the '168 patent.”). See *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 34 U.S.P.Q.2d 1565 (Fed. Cir. 1995) (holding that ranitidine hydrochloride is not inherently disclosed in its Form 2 crystalline polymorph in Example 32 of Plaintiff’s prior patent which disclosed a method of making Form 1 crystalline polymorph, wherein Defendant practiced Example 32 of the prior patent 13 times and always made Form 2 crystals, but wherein Plaintiff made Form 1 only once by practicing Example 32).

Appellents provide the following three examples to demonstrate that the DVT Reference does not **inherently** teach that the coffin is visually available to the first person.

A first example of why the DVT Reference does not **inherently** teach that the coffin is visually available to the first person is that there could be an opaque partition between Joe’s mother and the coffin that block’s a view of the coffin from Joe’s mother. There is no teaching anywhere in the DVT Reference that there is no opaque partition between Joe’s mother and the coffin that block’s a view of the coffin from Joe’s mother.

A second example of why the DVT Reference does not **inherently** teach that the coffin is visually available to the first person is that Joe’s mother could be in another room and be in telephone or equivalent electronic communication with Joe. There is no teaching anywhere in the DVT Reference that Joe’s mother is not in another room and in telephone or equivalent electronic communication with Joe.

A third example of why the DVT Reference does not **inherently** teach that the coffin is visually available to the first person is that the coffin could be in a closed room with no windows and no illumination wherein the room is pitch black such that the coffin is not visually available to anyone in the room. There is no teaching anywhere in the DVT Reference that the coffin in

not in a closed room with no windows and no illumination wherein the room is pitch black such that the coffin is not visually available to anyone in the room.

The preceding three examples are merely exemplary, and there are many other examples demonstrating that the DVT Reference does not **inherently** teach that the coffin is visually available to the first person.

Appellants note that the preceding argument in the Examiner's Answer in "Response To Argument" that the DVT Reference does not explicitly teach the preceding three examples is not persuasive, because the issue is not whether or not the DVT Reference teach any or all of the preceding three examples. The issue is whether it is **necessary and inevitable** from the teachings in the DVT Reference that the coffin is visually available to the first person. The three preceding examples provide scenarios in which the coffin is not visually available to the first person and the disclosure in the DVT Reference does not physically or logically exclude the possibility that one more of the preceding three examples may occur. Appellants reiterate, based on the case law cited *supra* (*Toro Co. v. Deere & Co.*; *Glaxo Inc. v. Novopharm Ltd.*), that a reference does not inherently teach X if X has a finite probability of occurring regardless of whether said finite probability is large or small.

Accordingly, Appellants contend that claims 1 and 19 are not anticipated by the DVT Reference.

As a second example of why the DVT Reference does not anticipate claims 1 and 19,

Appellants respectfully contend that the DVT Reference does not teach “directing the first person to see the second person as being in the coffin”. Page 8 of the DVT Reference is not relevant to this feature because the first person (Joe’s mother) is not mentioned on page 8 of the DVT Reference. On page 19 of the DVT Reference, the only direction received by Joe’s mother is: “I would have ... had his mother speak what was in her heart” which does not teach “directing the first person to see the second person as being in the coffin”. In other words, while page 19 of the DVT reference teaches directing Joe’s mother to speak to Joe, page 19 of the DVT Reference does not teach directing Joe’s mother to see Joe as being in the coffin.

The Examiner’s Answer has not cited anything in the DVT Reference that explicitly teaches “directing the first person to see the second person as being in the coffin”. Instead, the Examiner’s Answer in “Response To Argument” argues that the DVT Reference **inherently** teaches “directing the first person to see the second person as being in the coffin”.

In particular, the Examiner’s Answer In particular, the Examiner’s Answer in “Response To Argument” states: “If the first person (Joe's Mother) is directed to talk to the second person (Joe) while he is laying in a coffin, then she will **necessarily** see Joe in the coffin. There is no suggestion that the first person (Joe's Mother) be directed to look away, or otherwise isolate herself from the second person (Joe) while conversing with him. In order to communicate with Joe, she will **necessarily** see Joe as he is laying in the coffin.” (Emphasis added).

Appellants contend that the preceding argument in the Examiner’s Answer is incorrect, because having the first person directed to talk to the second person does not require that the first person look at the second person. Being directed to talk to the second person is being directed to communicate with the second person in a speaking mode. In contrast, being to see the second

person as being in the coffin is being directed to communicate with the second person in a visual mode. The first person could speak to the second person while the first person is not looking at the second person in the coffin and/or with the first person's eyes being closed. As explained *supra*, in order for the DVT Reference to **inherently** teach "directing the first person to see the second person as being in the coffin", it must **necessarily and inevitably** follow from the disclosed matter in the DVT Reference that the first person is directed to see the second person as being in the coffin. The Examiner's Answer has not demonstrated that it **necessarily and inevitably** follows from the disclosed matter in the DVT Reference that the first person is directed to see the second person as being in the coffin.

Accordingly, Appellants contend that claims 1 and 19 are not anticipated by the DVT Reference.

As a first additional matter specific to claim 19, Appellants respectfully contend that the DVT Reference does not teach the following feature of claim 19: "questioning a first person using first questions having **predetermined fixed responses**" (emphasis added).

The Examiner's Answer alleges: "Prior to the implementation of the method, both the first person (Joe's Mother) and the second person (Joe) are questioned (page 6, entire page)."

In response, Appellant's note that the only question asked of the first person (identified by the Examiner's Answer as Joe's mother) is: "Is that correct?" Mom's response is: "I would gladly give my kidney, my life, or anything he needs." Hence Appellants maintain that from the context of the preceding question and answer, the preceding question is not a question having a predetermined fixed response as required by claim 19.

The Examiner's Answer argues: "Page 6 of the DVT booklet describes pre-testing of the subject prior to administering the coffin visualization steps. The questions being asked have pre-determined responses. For example, the therapist asks of the first person (Joe's Mother): "Is that Correct?" Pre-determined responses would be "Yes" or "No" or "I would" or "I would not"."

Appellants contend that the preceding argument in the Examiner's Answer is not persuasive, because there is no disclosure in the DVT Reference that such responses as "Yes", "No", "I would", "I would not", etc. are fixed and predetermined.

As a second additional matter specific to claim 19, Appellants respectfully contend that the DVT Reference does not teach the following feature of claim 19: **"if the evaluating determines that the therapeutic method should continue: providing ...; having...;directing...; and instructing"** (Emphasis added). Appellants maintain that page 6 of the DVT Reference does not teach performing the additional method steps ("providing ...; having...;directing...; and instructing") **conditionally** based on whether "the evaluating determines that the therapeutic method should continue", as required by claim 19.

The Examiner's Answer argues: "The entire purpose of the questions is to determine whether to initiate the method. If Joe were to state that he had no animosity towards his mother, there would be no logical reason to proceed."

Appellants contend that the preceding argument in the Examiner's Answer is not persuasive, because there is no disclosure in the DVT Reference that "[t]he entire purpose of the questions is to determine whether to initiate the method". Additionally, there is no disclosure in the DVT Reference that the method does not perform the additional steps ("providing ...;

having...,directing...; and instructing”) if Joe were to state that he had no animosity towards his mother.

Indeed, the DVT Reference does not limit reasons and scenarios for which Death Visualization Therapy may be used. For example, the DVT Reference recites on page 28: “Death Visualization Therapy can also be used for other situations **which include but are not limited to** counseling, drug rehabilitation, road rage, and promiscuity issues.” (emphasis added)

Based on the preceding arguments, Appellants respectfully maintain that does not anticipate claims 1 and 19, and that claims 1 and 19 are in condition for allowance.

Claim 5

Appellants maintain that the DVT Reference does not teach “wherein the directing and instructing steps are performed by a facilitator”.

The Examiner’s Answer argues: “The steps are performed by a facilitator (page 9, lines 9-13 and page 19, lines 8-13)”.

In response, Appellants maintain that page 9 of the DVT Reference does not teach the step of directing the first person (Joe’s mother) to see the second person (Joe) as being in the coffin is performed by a facilitator (the therapist). Indeed, on page 9, of the DVT Reference, the therapist communicates only with Joe and does not communicate at all with Joe’s mother.

In further response, Appellants maintain that page 19 of the DVT Reference does not teach the step of directing the first person (Joe’s mother) to see the second person (Joe) as being in the coffin is performed by a facilitator (the therapist). Indeed, on page 19 of the DVT

Reference, the therapist communicates with Joe's mother by having "his mother speak what was deepest in her heart" which is not a disclosure of "directing the first person to see the second person as being in the coffin" as required by claim 5.

In "Response to Argument", the Examiner's Answer argues: "First, both pages 9 and 19 discuss the instructive actions of the facilitator. Secondly, if there was no facilitator, there is no suggestion that Joe and his mother would have gone out on their own initiative and obtained a coffin or related theatrical devices and practiced the claimed method steps on their own. The facilitator provides both the equipment and the instruction necessary to perform the claimed method and there is no suggestion in the DVT booklet that the steps are practiced without the facilitator being present."

In response, Appellants note that the preceding argument in "Response to Argument" uses language such as "there is no suggestion" which may be appropriate for an obviousness rejection under 35 U.S.C. §103(a) but is not persuasive for an anticipation rejection under 35 U.S.C. §102(b). The correct test is whether the DVT Reference explicitly or inherently teaches the feature of "wherein the directing and instructing steps are performed by a facilitator". Appellants maintain that the Examiner's Answer has not persuasively demonstrated that the DVT Reference explicitly or inherently teaches the feature of "wherein the directing and instructing steps are performed by a facilitator". As discussed *supra*, a reference does not inherently teach X if X has a finite probability of occurring regardless of whether said finite probability is large or small.

Therefore, claim 5 is not anticipated by the DVT Reference.

Claim 7

Appellants maintain that the DVT Reference does not teach “wherein the coffin includes a pillow that is visually available to the first person”.

The Examiner’s Answer argues: “The coffin includes a visible pillow (page 8, line 3)”.

In response, Appellants maintain that page 8 of the DVT Reference does not teach the pillow is visually available to the first person (Joe’s mother). Indeed, Joe’s mother is never mentioned on page 8 of the DVT Reference.

In “Response to Argument”, the Examiner’s Answer argues: “In the DVT booklet, the first person is Joe’s mother. The DVT booklet states at page 8, line 3 that the coffin has a pillow. Accordingly, when Joe lays in the coffin (page 19), and his mother talks to him (page 19), it stands to reason that she will see both Joe and the coffin he is laying in, as well as anything associated with the coffin.”

In response, Appellants note that the preceding argument in “Response to Argument” uses language such as “it stands to reason” which may be appropriate for an obviousness rejection under 35 U.S.C. §103(a) but is not persuasive for an anticipation rejection under 35 U.S.C. §102(b). The correct test is whether the DVT Reference explicitly or inherently teaches the feature of “wherein the coffin includes a pillow that is visually available to the first person”. Appellants maintain that the Examiner’s Answer has not persuasively demonstrated that the DVT Reference explicitly or inherently teaches the feature of ““wherein the coffin includes a pillow that is visually available to the first person”. As discussed *supra*, a reference does not inherently teach X if X has a finite probability of occurring regardless of whether said finite probability is large or small.

Therefore claim 7 is not anticipated by the DVT Reference.

Claim 13

Appellants maintain that the DVT Reference does not teach the following feature of claim 13: “after the instructing step, questioning the first person using questions having predetermined fixed responses and pertaining to the first person's attitude toward the second person”.

The Examiner's Answer argues: “Both the first person (Joe's mother) and te second person (Joe) are questioned after the completion of the session (page 20, line 21: page 15, lines 19-27)”.

In response, Appellants maintain that on page 20 of the DVT Reference, there is no teaching that the first person (Joe's mother) is questioned. Also in response, Appellants maintain that on page 15 of the DVT Reference, the first person (Joe's mother) is asked the question: “Mom, how do you fee right now?”, which is not a question having a predetermined fixed responses as required by claim 13.

In “Response to Argument”, the Examiner's Answer argues: “In the DVT reference, the first person is Joe's Mother. Page 15, lines 19-27 set forth a question directed to Joe's Mother. The question requires a pre-determined response, in particular, a response relating to how she feels, such as good, neutral or bad. It cannot be just any response .”

In response, Appellants maintain that the Examiner has not persuasively demonstrated that “[t]he question requires a pre-determined response”, especially since the question on page 15 of the DVT Reference is the **open-ended question** of “Mom, how do you feel right now?”.

Moreover, the allegation in the Examiner's Answer that “[t]he question requires a

pre-determined response, in particular, a response relating to how she feels, such as good, neutral or bad.” is directly contradicted by the following actual response on page 15 of the DVT Reference: “**I do feel a lot closer to Joe** I’m glad he went through this. I can see it was a good wake-up call. I’m sorry he had to suffer in that room but I’m very glad what has happed. **I feel hopeful.**” (emphasis added)

Therefore claim 13 is not anticipated by the DVT Reference.

Claim 14

Appellants respectfully contend that the DVT Reference does not teach the following feature of claim 14: “directing the first person to envision himself or herself as being at his or her moment of despair (MOD) in relation to a destructive habit that the first person has.”

The Examiner’s Answer argues: “[w]hen the first person (Joe's Mother) is directed to speak to the second person (Joe), the first person (Joe's Mother) is speaking to Joe as if he had died and is laying in a coffin, which would be a moment of despair. The destructive habit can be drug abuse or road rage, as illustrated on page 28. ”.

In response, Appellants maintain that the Examiner’s Answer’s identified moment of despair (MOD) is not relation to a destructive habit that the first person (Joe’s mother) has, as required by claim 14. The citation to page 28 of the DVT Reference is misdirected, because page 28 of the DVT Reference merely states that “Death Visualization Therapy can also be used for other situations which include but are not limited to counseling, drug rehabilitation, road rage, and promiscuity issues.” In other words, page 28 of the DVT Reference is a general statement about the subject areas in which Death Visualization Therapy can beneficially employed.

However, page 28 of the DVT Reference does not recite anything about how counseling, drug rehabilitation, road rage, etc. is explicitly dealt with during performance of the Death Visualization Therapy methodology. In particular, there is no text in the DVT Reference that teaches “directing the first person to envision himself or herself as being at his or her moment of despair (MOD) **in relation to a destructive habit that the first person has**” (emphasis added).

The Examiner’s Answer additionally argues: “The recitation that the first person actually has the destructive habit carries no patentable weight. The psychological characteristics of the person performing the method does not limit the method steps. The claim is limited by the steps themselves, not the personal characteristics of the person performing the steps.”

In response, Appellants maintain that the “destructive habit that the first person has” limits the step of “directing the first person to envision himself or herself as being at his or her moment of despair (MOD)”, because the first person is being directed to constrain his or her envisioning at his or moment of despair to the context of a destructive habit, as opposed to some other context such as, for example, an inability to memorize names of persons that he or she is introduced to.

Therefore claim 14 is not anticipated by the DVT Reference.

Claim 15

Appellants respectfully contend that the DVT Reference does not teach the following feature of claim 15: “conditioning the first person to use a trigger to induce a power thought in the first person.”

The Examiner’s Answer argues: “The coffin used in the method serves as a trigger to

induce specific thoughts leaning to specific new behaviors”.

In response, Appellants maintain that the example in the Examiner’s Answer does not relate to a “power thought”. Page 11, lines 1-3 of the specification defines “power thought” as follows: “ A ‘power thought’ in the first person 12 is a thought by the first person 12 that envisions the destructive habit as causing an adverse consequence to the first person 12.”

Appellants contend that the Examiner’s example does not relate to a thought that envisions the destructive habit as causing an adverse consequence to the first person (Joe’s mother).

Therefore, the Examiner’s example does not relate to a “power thought” and therefore has no relevance to claim 15.

In “Response to Argument”, the Examiner’s Answer argues: “Argument is made that the “power thought” of the DVT reference does not call for the envisioning of a destructive habit as causing adverse consequences. This argument is considered moot because the claim does not define the nature of the “power thought”.”

In response, Appellants maintain that although limitations in the specification are not generally read into the claims, definitions in the specification are read into the claims. Appellants maintain that the previously quoted language on page 11, lines 1-3 of the specification states a definition of “power thought” and is therefore used to construe the meaning of “power thought” in the claims.

In “Response to Argument”, the Examiner’s Answer additionally argues: “Additionally, it is highly questionable as to whether a person’s thoughts actually limit the content of claimed method step, since the thought itself does not constitute a method step or an action being taken.”

In response, Appellants maintain that “to induce a power thought in the first person” is a

limitation on the step “of conditioning the first person to use a trigger” since said step would be performed differently if the conditioning is directed to accomplish something other than “to induce a power thought in the first person”. In other words, the manner of performing the conditioning is a function of what is intended to be conditioned.

In “Response to Argument”, the Examiner’s Answer additionally argues: “Even if the “power thought” were given its full meaning as ascribed by appellant, it is taught on page 19, where the first person (Joe's mother) is described as weeping as a result of seeing Joe in a coffin (associating Joe's behavior with death).”

In response, Appellants maintain that the claim feature of “conditioning the first person to use a trigger to induce a power thought in the first person” does not read on the subject matter discussed on page 19 of the DVT Reference.

Therefore claim 15 is not anticipated by the DVT Reference.

Claim 16

In addition, Appellants respectfully contend that the DVT Reference does not teach the following feature of claim 16: “directing the first person to pledge using a trigger for regularly inducing a power thought in the first person”

The Examiner’s Answer argues: “Both the first person (Joe's Mother) and the second person (Joe) are directed to make pledges (page 23, lines 11-12; page 17, lines 1-4; page 17 lines 13-19, page 28, line 7)”.

In response, Appellants maintain that the first person (Joe’s mother) is not discussed at all on pages 17, 23, and 28. Also in response, no pledge discussed on pages 17, 23, and 28 is a

pledge using a trigger for regularly inducing a power thought in the first person (Joe's mother), as required by claim 16. Pages 17 and 23 describe the pledge being made by the second person (Joe). Page 28 describes a pledge applicable to either Joe (second person) or Joe's Mother (first person) and thoughts about the consequences of what will occur."

In response, Appellants maintain that the Examiner citation to pages 17 and 23 of the DVT Reference is misdirected, because claim 16 comprises "directing the **first person** to pledge ...", whereas pages 17 and 23 of the DVT Reference pertains to a pledge by the second person. In further response, Appellants maintain that pages 28 of the DVT Reference recite a pledge "to long range intentions of showing more respect". However, pages 28 of the DVT Reference does not teach that the preceding pledge directed to "using a trigger for regularly inducing a power thought in the first person" as required by claim 16.

Therefore claim 16 is not anticipated by the DVT Reference.

Claim 17

Appellants respectfully contend that the DVT Reference does not teach the following feature of claim 17: "wherein the destructive habit includes a habitual practice selected from the group consisting of a habitual using of an illegal drug, a habitual smoking of tobacco, a habitual drinking of alcoholic beverages to a point of intoxication, a habitual aggressive driving of a motor vehicle, and a habitual showing of parent disrespect".

The Examiner's Answer argues: "The destructive habit primarily described in the Death Visualization Therapy book is parental disrespect, but other behaviors such as drug use and road rage are discussed (page 28, lines 18-20)".

In response, Appellants maintain that the destructive habit of claim 17 is the destructive habit of the first person (Joe's mother) as seen from the antecedent basis of destructive habit in claim 14. Appellant's content that the DVT Reference does not disclose that Joe's mother has any of the destructive habits recited in claim 17.

In "Response to Argument", the Examiner's Answer argues: "Claim 14 calls for the first person (Joe's Mother) to be at a moment of despair in relation to a destructive habit. The action of talking to someone in a coffin (page 19) and weeping (page 19) would logically be actions of despair. What the despair is about would require an analysis of her internal thought processes, which carry no patentable weight. What a person is thinking is not a method step and is not considered to be limiting of a claim addressed to a method step. If alternatively, it were ascribed patentable weight, the feature is taught at page 28 of DVT. The despair can be caused by road rage or drug usage, both of which are destructive habits that can afflict either the first person or second person."

In response, Appellants contend that the preceding argument in the Examiner's Answer is not pertinent to the fact that claim 17 recites a destructive habit of the first person (Joe's mother), and the DVT Reference does not disclose that Joe's mother has any of the destructive habits recited in claim 17.

Therefore claim 17 is not anticipated by the DVT Reference.

Claim 21

Appellants respectfully contend that the DVT Reference does not teach the following feature of claim 21: "after the instructing step, questioning the first person using second questions having

predetermined fixed responses and pertaining to the first person's attitude toward the second person”.

The Examiner’s Answer argues: “See remarks for claim 13”.

In response, Appellants make reference to Appellants arguments relating to claim 13.

Ground of Rejection 2

Claims 9-10 stand rejected as allegedly being unpatentable under 35 U.S.C. §103(a) over Death Visualization Therapy, by Arnold P. Nerenberg, PhD in view of Official Notice.

Hereinafter, the reference of “Death Visualization Therapy” by Arnold P. Nerenberg, PhD is identified as the “DVT Reference”.

Appellants respectfully contend that the DVT Reference does not teach the following feature of claims 9 and 10: “operating an electronic device, said electronic device located within the coffin” (claim 9) and “wherein the electronic device is selected from the group consisting of an audio device, a video device, and combinations thereof” (claim 10).

The Examiner’s Answer admits: “Claims 9-10 differ from the Visualization Therapy booklet in that the book does not specifically recite the presence of audio or video devices”. The Examiner’s Answer argues: “Examiner takes Official Notice that the usage of audio or video devices to record the statements or behavior of individuals is very well known in psychology and psychotherapy.... It would have been obvious to one of ordinary skill in the art to modify the Death Visualization Therapy method in order to include recording devices so as to permit accurate recording and playback of the patient's behavior, as is well known in the art.”.

In response, Appellants contend that the Examiner’s Answer has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify the DVT Reference by the Examiner’s alleged Official Notice in relation to claims 9-10. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286,

1293 (Fed. Cir. 2001 (“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention.”). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984 (“The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art suggested the desirability of the modification.”)). Appellant maintains that the Examiner’s Answer has not made any showing of where the prior art suggests incorporation of an electronic device within a coffin. Thus, the Examiner’s Answer has created a reason for the combination that the Examiner’s Answer has not supported by the cited prior art. By not citing any suggestion or incentive in the prior art for incorporating an electronic device within a coffin, the Examiner’s Answer has failed to establish a *prima facie* case of obviousness in relation to claims 9-10.

In “Response to Argument”, the Examiner’s Answer argues: “The final rejection recites the motivation of providing accurate recording and playback of the patient's behavior. This motivation would have been well understood by the person of ordinary skill in the art using recording equipment”.

In response, Appellants note that the preceding argument “Response to Argument” in the Examiner’s Answer does not provide motivation in the prior art for modifying the DVT Reference as required by case law, but instead provides motivation originating from the Examiner.

Therefore claims 9-10 are not unpatentable under 35 U.S.C. §103(a) over the DVT Reference in view of Official Notice.

Additional Discussion on Applicability of DVT Reference:

1. Discussion in Examiner's Answer on Applicability of DVT Reference

Appellants respectfully dispute the allegation in the Examiner's Answer that the DVT Reference is a reference that could be used against the claims of the present patent 35 U.S.C. §102(b). At issue is the date at which the DVT Reference became publicly available. The Examiner's Answer alleges that the date at which the DVT Reference became publicly available is March 20, 1999, based on the following argument: "The reference to Death Visualization Therapy is a booklet published by the inventor of record in the present application. Records from the U.S. Copyright Office indicate that a copyright for this booklet was registered on December 27, 1999. A copy of the copyright record obtained from the U.S. Copyright Office pertaining to this same booklet indicates publication on March 20, 1999. Since the publication date of March 20, 1999 is more than one year prior to the effective filing date of the present application, and meets the requirement of being "described in a printed publication" under 35 USC 102(b), the reference to Death Visualization Therapy is considered to be applicable as prior art under 35 USC 102(b)."

In "Response to Argument", the Examiner's Answer states:

"The conclusion that the DVT reference is applicable as prior art under 35 USC 102(b) is based on several fundamental reasons:

(1) Appellant's copyright registration for this same booklet clearly indicates a first publication on March 20, 1999, and copyright statute indicates that such publication is a distribution to the public.

(2) Appellant's signature on the copyright registration verifies that the statements made in the copyright registration were correct.

(3) Appellant has submitted a declaration under 37 CFR 1.132 (Declaration of October 31, 2003) which claims that only a single copy was printed and such copy was not distributed. However, there is no factual evidence to support this allegation. Appellant has submitted invoice dated December 20, 1999 which requests publication of the booklet, but this invoice does not explain what happened to the publication or publications of March 20, 1999 referred to in the copyright application.”

2. Appellants’ Analysis of *Ex parte Research and Mfg. Co.*

Appellants respectfully contend that the date at which the DVT Reference became publicly available is after December 20, 1999, based on the following analysis, supported by the case of *Ex parte Research and Mfg. Co.*, 10 USPQ.2d 1657 (Bd. Pat. App. & Interferences March 9, 1989). In *Ex Parte Research and Mfg. Co.*, the Board reversed the Examiner’s rejection of claims 1, 11, and 21 under 35 U.S.C. §102(b) as allegedly being anticipated by a publication identified as the Sorvall bulletin. The basis for the Examiners rejection was that the Sorvall bulletin was listed on a copyright registration form as having a date of publication of June 2, 1969, which is more than one year prior to the filing of the patent application at issue. The Board’s analysis for reversing of the Examiner’s rejection is as follows:

“[T]he certificate of registration provides *prima facie* evidence that the Sorvall bulletin²⁶⁻²⁹ was a ‘printed publication’ under the provisions of 35 USC 102(b).

However, the *prima facie* evidence may be rebutted by convincing factual evidence to the contrary. As rebuttal evidence, appellant has presented copies of a letter from Mr. Clutter

to Dr. Christensen dated May 28, 1969 requesting that Dr. Christensen "review" a "supplementary bulletin detailing the FTS that John Evans wanted to take on his tour of Europe." Also of record is a return letter from Dr. Christensen to Mr. Clutter dated June 5, 1969 stating that Dr. Christensen had "taken the liberty of revising the text, and a copy of the revised version is enclosed." Attached to Dr. Christensen's letter is a copy of what is asserted to be the revision. Additionally, appellant has proffered an affidavit of Cyrus G. Lindgren dated September 5, 1987, in which Mr. Lindgren asserts that "Bulletin 26-69 was printed as preliminary product information for use within the company," and that "Bulletin 26-69 was not distributed to sales personnel of Ivan Sorvall, Inc. or others" because it had [*14] been "immediately criticized and revised by Dr. Christensen resulting in the preparation of Bulletin 28-69. Copies of Bulletin 26-69 were therefore of no use to the company and were destroyed." Mr. Lindgren also states that, with regard to the application for Copyright Registration A90038, that he "recalls that he did not, himself, prepare this application," and "states to the best of his knowledge that the June 2, 1969 date contained in Sections 4 and 11 of the application referring to the date of publication of Bulletin 26-69 is inaccurate. This Bulletin was never put into use or distributed . . ."

On the basis of the evidence before us, it seems apparent that the Sorvall Supplementary Bulletin 26-69 was only distributed within the company and to Dr. Christensen. Although there were apparently no restrictions placed on Dr. Christensen's use of the bulletin, Dr. Christensen was, in our view, within the employ of Ivan Sorvall, Inc., and therefore the bulletin apparently was never circulated or distributed outside the company or its employees. We refer to the letter of Dr. Christensen to Mr. Baranowski dated June 3, 1987 (Patent Owner's citation BI, Paper No. 11) as evidence [*15] of the relationship between Sorvall and Dr. Christensen. Dr. Christensen states in the penultimate paragraph thereof that "[m]y financial arrangement with Sorvall was a 5% royalty on all FTS instruments sold for the first 5 years. After the 5 years were up, I had little further contact with Sorvall."

Thus, in view of the evidence before us, it appears that the Sorvall Supplementary Bulletin 26-69 was not "placed on sale, sold, or publicly distributed" (17 USC 26). Therefore, not only was the June 2, 1969 date "inaccurate" as the date of publication, but the Sorvall Supplementary Bulletin 26-69 was not even "published" under the meaning of the copyright laws. Therefore, we find that the evidence of record rebuts the *prima facie* evidence of the fact stated in item 4 of the application for registration of a claim to copyright that June 2, 1969 was the date of publication of the Sorvall Supplementary Bulletin FTS 26-69."

Id. at 1660-61.

Thus, the Board first considered that the publication date on the copyright registration to be *prima facie* evidence of a date of publication of June 2, 1969 of the Sorvall bulletin. Then, the

Board held that the date of June 2, 1969 was not the date of publication of the Sorvall bulletin, based on the rebuttal evidence submitted. For the present patent application, Appellants next provide arguments as to why an application of the Board's holding in *Ex parte Research and Mfg. Co.* leads to the conclusion that the date of publication of the DVT Reference used to reject claims of the present patent application does not have the publication date of March 20, 1999 listed on the DVT Reference copyright application.

The following rebuttal evidence was submitted in *Ex parte Research and Mfg. Co.*:

- 1) the letter from Mr. Clutter to Dr. Christiansen;
- 2) the return letter from Dr. Christiansen to Mr. Clutter; and
- 3) Mr. Lingren's affidavit.

Similarly, Appellants have offered the following rebuttal evidence:

- 1) a receipt for 110 copies of the DVT Reference dated December 22, 1999 filed on October 28, 2003 as Exhibit A to Dr. Nerenberg's Declaration under 32 CF.R. §1.132; and
- 2) Dr. Nerenberg's Declaration under 32 CF.R. §1.132 filed on October 28, 2003 with Appellants' office action response.

Appellants submit that Appellants' rebuttal evidence item 1) (receipt for 100 copies) is analogous to rebuttal evidence items 1) and 2) in *Ex parte Research and Mfg. Co.* (Letter and return letter). For both cases (i.e., *Ex parte Research and Mfg. Co.* and the instant patent application) said rebuttal evidence does not rigorously prove that the publication at issue was not

published on the date of publication listed on the copyright application. The letter and return letter in *Ex parte Research and Mfg. Co.* is merely indicative of an allegation that the original copy existing on June 2, 1969 was edited after June 2, 1965, but does not rigorously prove that the original copy existing on June 2, 1969 was not publicly available on June 2, 1969. Similarly, the receipt for 100 copies in the instant case does not rigorously prove that the copy of the DVT reference existing on March 20, 1999 was not publicly available on March 20, 1999.

Nonetheless, the rebuttal evidence items 1) and 2) in *Ex parte Research and Mfg. Co.* were considered by the Board as persuasive as providing evidence on non-publication, even though said rebuttal evidence items 1) and 2) do not negate the possibility that the Sorvall publication could have been publicly available on June 2, 1969. Similarly, the receipt for the 100 copies in the instant case is evidence in support of a need to make the DVT reference publicly available after December 20, 1999, since it is normal practice to publish multiple copies of a book when making a book publicly available. Moreover, with only a single copy existing on March 20, 1999 it is reasonable to suppose that the author Dr. Nerenberg would want to keep the single copy (and only existing copy) for himself until such time that other copies could be made for available or distribution to others. In any event, Appellants respectfully maintain that the receipt for the 100 copies in the instant case is at least as persuasive (as rebuttal evidence) as is items 1) and 2) in *Ex parte Research and Mfg. Co.* Thus, Appellants respectfully submit that the receipt for the 100 copies in the instant case is sufficiently persuasive, based on *Ex parte Research and Mfg. Co.*

Appellants additionally submit that Appellants' rebuttal evidence item 2) (Declaration under 32 CF.R. §1.132) is analogous to rebuttal evidence item 3) in *Ex parte Research and Mfg. Co.* (Mr. Lingren's affidavit). First, Mr. Lingren's affidavit asserts that the Sorvall Bulletin was

not distributed to sales personnel of Ivan Sorvall, Inc. or others. Similarly, Dr. Nerenberg's Declaration asserts that the single copy of the DVT Reference was not publicly distributed or made publicly available. Second, Mr. Lingren's affidavit asserts that Mr. Lingren did not prepare the copyright application. Analogously, Dr. Nerenberg asserts that Dr. Nerenberg prepared the copyright application himself without the assistance or advice of legal counsel and that he mistakenly thought that the date of publication on the copyright application meant the date of printing. Appellants maintain that Dr. Nerenberg's Declaration is probably more persuasive than Mr. Lingren's affidavit, since Mr. Lingren did not produce any evidence that the person who filled out the copyright application was under a mistaken impression that the date of publication on the copyright application meant something other than the date of public availability. Yet, the Board found Mr. Lingren's affidavit to be persuasive. In any event, Appellants respectfully maintain that Dr. Nerenberg's Declaration in the instant case is at least persuasive (as rebuttal evidence) as is Mr. Lingren's affidavit in *Ex parte Research and Mfg. Co.* Thus, Appellant's respectfully submit that Dr. Nerenberg's Declaration in the instant case is sufficiently persuasive, based on *Ex parte Research and Mfg. Co.*

3. Analysis of *Ex parte Research and Mfg. Co.* In Examiner's Answer

In response to Appellants' preceding analysis based on *Ex parte Research and Mfg. Co.*, the Examiner's Answer in "Response to Arguments" argues: "A case law citation has also been presented by appellant, *Ex Parte Research and Mfg. Co.*, 10 USPQ 2d 1657 (Bd. Pat. App. & Interferences, March 9, 1989). The case pertains to a scenario in which date of publication listed in a Copyright Registration "A90038" was rebutted by factual evidence. However, in this case, the

copyright registrations were rebutted by letters written by a third party participants ("Mr. Clutter", "Dr. Christensen" and "Mr. Baronowski"). No such third party information appears in this application. In addition, this case involved a scenario where the evidence demonstrated that the document in question was never even published. In the present case, applicant admits to publishing at least one booklet more than one year prior to the effective filing date."

4. Appellants' Response to Analysis of *Ex parte Research and Mfg. Co.* In Examiner's Answer

In response to the preceding argument "Response to Argument" in the Examiner's Answer, Appellants contend:

1) The allegation in the Examiner's Answer that the copyright registrations were rebutted by letters written by third party participants represents a distortion of the Board's analysis in *Ex Parte Research and Mfg. Co.* In particular, the Board held that: "On the basis of the evidence before us, it seems apparent that the Sorvall Supplementary Bulletin 26-69 was only distributed within the company and to Dr. Christensen".

The primary evidence supporting the Board's decision that "the Sorvall Supplementary Bulletin 26-69 was only distributed within the company ..." is the "affidavit of Cyrus G. Lindgren dated September 5, 1987, in which Mr. Lindgren asserts that "Bulletin 26-69 was printed as preliminary product information for use within the company," and that "Bulletin 26-69 was not distributed to sales personnel of Ivan Sorvall, Inc. or others" because it had been "immediately criticized and revised by Dr. Christensen resulting in the preparation of Bulletin 28-69. Copies of Bulletin 26-69 were therefore of no use to the company and were destroyed."".

Appellants contend that Mr. Lindgren was not a third party participant. Appellants further

contend that Dr. Nerenberg's Declaration under 32 CF.R. §1.132 filed on October 28, 2003 is analogous to Mr. Lindgren's affidavit.

Moreover, there is no indication in the Board's analysis of any legal significance to writings by third parties in comparison with writings by parties who are not third parties.

2) The Examiner's argument is based on incorrect reasoning. In particular, the Examiner's Answer states: "In addition, this case involved a scenario where the evidence demonstrated that the document in question was never even published. In the present case, applicant admits to publishing at least one booklet more than one year prior to the effective filing date".

Appellants assert that both the copyright application in *Ex Parte Research and Mfg. Co.* and the copyright application at issue in the instant appeal state a publication date more than a year prior to the effective filing date of a patent application. Therefore, Appellants' copyright application represents an admission of publication to the same extent that the copyright application in *Ex Parte Research and Mfg. Co.* represents an admission of publication. Accordingly, the Examiner's Answer incorrectly alleges a distinction based on an "admission".

3) The Examiner's Answer has not provided a legally persuasive analysis of *Ex Parte Research and Mfg. Co.* and has not presented any counter analysis that negates Appellants' analysis of *Ex Parte Research and Mfg. Co.* Accordingly, Appellants' analysis of *Ex Parte Research and Mfg. Co.* has not been effectively rebutted or challenged in the Examiner's Answer.

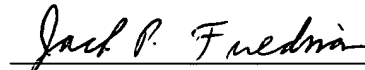
5. Conclusion

Based on Appellants' preceding analysis, Appellants respectfully contend that the holding in the *Ex parte Research and Mfg. Co.* case supports Appellants' contention that the DVT Reference cannot be used as prior art against the claims in the present patent application.

SUMMARY

In summary, Appellant respectfully requests reversal of the rejection of claims 1, 4-10, 12-17 and 19-21.

Respectfully submitted,



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